

REMARKS

Applicants have not received a signed copy of the PTO-1449 Form regarding the IDS filed October 28, 2002. Applicants respectfully request a signed copy.

Regarding the assertion in the Office Action that Singhvi teaches a "masking system wherein a mask may be positioned between a surface and a source of irradiation to form a patterning device per se," Applicants note that, although the masking system is Singhvi may be used to create a patterning device useful in cell patterning, the masking system is not directly used to pattern cells on a surface.

By the present amendment, claims 1, 4, 8, 12, 19, and 45 have been amended. Claims 3, 5-7, 10, and 17-18 have been cancelled without prejudice or disclaimer. New claims 46 and 47, which depend from claims 2 and 45, respectively, have been added. Claims 1-2, 4, 8-9, 11-16, 19-23, and 45-47 are pending in the application. No new matter has been added.

REJECTIONS

Rejection of claims 1-23 and 45 under 35 U.S.C. §103(a)

Claims 1-23 and 45 were rejected under 35 U.S.C. §103(a) as being unpatentable over newly cited WO 99/54786 in view of Singhvi et al., U.S. Patent No. 5,776,748 ("Singhvi"), and over Singhvi in view of WO 99/54786.

The Office Action appears to state in ¶ 8 that the motivation for combining WO 99/54786 with Singhvi is that WO 99/54786 teaches patterning biochemical agents on surfaces, while Singhvi teaches the application of cells to surfaces using a stamping system. The Office Action states that "The suggestion is clear with the newly applied art combination that one of skill in the art would have been motivated to apply cells onto the agent via a masking system. Each of the claim limitations are disclosed or are at least suggested by the WO patent and Singhvi."

The applicants the both independent claims 1 and 45 have been amended to recite that cells are applied to the second portion of the surface of the article through the mask, which is subsequently removed. Nowhere do the cited references, alone or in combination, disclose or

thus do not explicitly recite this however
suggest applying cells to a surface through a mask positioned on the surface of an article. The Patent Office has not suggested otherwise.

In the Office Action, the Patent Office has not even indicated where in WO 99/54786 is the use of cells taught, suggested, or motivated at all. Instead, the Patent Office appears to assert that the "biochemical recognition" in the masking system of WO 99/54786 would motivate one of ordinary skill in the art to use cells as described in the stamping system of Singhvi. Although the Patent Office has stated that "the suggestion is clear," the Patent Office has not indicated where in Singhvi is there such a suggestion that cells are equivalent to biochemical interactions. While Applicants do not concede the merits of this contention, even if, solely for the sake of argument, it is presumed to be true, nowhere does either reference disclose, suggest, or motivate applying cells through a channel within the masking system while it is in contact with the surface of the article, as claims 1 and 45, as amended, recite.

Despite the complete absence of any specific suggestion in the cited references of applying cells through a channel within the masking system while it is in contact with the surface of the article, the Office Action, nevertheless, states in ¶ 9 that "[t]o provide a surface for cells to be applied within at least one channel of a masking system as disclosed by the WO patent cited above, is clearly an obvious step and one of skill would have been motivated by the combined teachings of Singhvi and WO patent to form patterns of cells using such a method." While it is not clear to the Applicants from the above quoted language from the Office Action if the Patent Office is suggesting that method that involves applying cells through a channel within the masking system is also an obvious extension and modification of the combined teachings of the applied references, if such a suggestion is indeed being made, the Applicants believe that the Patent Office is clearly relying only on hindsight in formulating this contention, as it has absolutely no support in either reference alone or in combination.

The Patent Office states that the motivation to combine the references is that both teach "methods of patterning." The Patent Office also asserts that one of skill in the art would have been motivated by "the combined teachings of Singhvi and WO patent." However, the Patent Office has not pointed to any specific suggestion or a motivation in either WO 99/54786 or Singhvi for one of ordinary skill in the art to combine the references in any way, let alone in such

*page 21, line 1-10
biological agents
also teaches
at Pg 18
line 11-12
first of
into a
channel
thus a
suggestion*

a manner including the additional modification of applying cells to the surface through a channel within the masking system, as would be necessary for a *prima facie* case of obviousness of the claims as amended.

Applicants therefore believe the instant application is patentably distinct over Singhvi in view of WO 99/54786, and Applicants respectfully requested that the rejections of independent claims 1 and 45 under 35 U.S.C. §103(a) be withdrawn. Claims 2, 4, 8-9, 11-16, and 19-23 depend from and include all of the limitations of independent claim 1, as amended, and are believed to be patentable over the applied references for at least the reasons stated above with regard to claim 1. Reconsideration and withdrawal of the rejection of these claims on the present grounds is also, therefore, respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this affect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicants' attorney at the number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee

Serial No.: 09/808,745
Confirmation No. 4346

- 9 -

Art Unit: 1651

occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge the deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
Ostuni et al., Applicants

By: 

Timothy J. Oyer, Reg. No. 36,628
Tani Chen, Reg. No. 52,728
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210
Tel. (617) 720-3500
Fax (617) 720-2441

Docket No.: H00498.70135.US
Date: June 25, 2003
06/25/03